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10/774,641	02/09/2004	Ulrich Noack	2694-0140P	8792

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EXAMINER

MASINICK, MICHAEL D

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/774,641

Applicant(s)

NOACK, ULRICH

Examiner

Michael D. Masinick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

This applicant was filed without an information disclosure statement, but makes reference in the specification to related applications ("Setting and measuring the pressing force is known, for example from EP 0 698 481 B1"). The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Priority date is set to Feb 10, 2003.

### ***Claim Objections***

2. Claims 1 and 8 are objected to because of the following informalities: Claims 1 and 8 have no clearly defined preamble. The term "wherein" is used late in the claims and is put in bold font, however it is unclear where the metes and bounds of the claim are meant to begin. Claims 2-7 inherit this deficiency.

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3. Claims 1 is further objected to because of the term “the determined pressing force” in line 9. This pressing force has not been previously determined and cannot be referred to in past tense without causing an antecedent basis issue.
4. Claim 2 is objected to on similar grounds in that it brings in the step of “measuring” the pressing force. Examiner is confused as to how a pressing force can be “determined” in claim 1 without being measured. Appropriate correction or explanation is requested.
5. Examiner would also prefer all illustration numbers be removed from the claims unless applicant feels they are important to the claim interpretation.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Regarding claim 4, A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948);

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and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "between 1 and 50%", and the claim also recites two other ranges which are narrower statements of the range/limitation.

8. It is further noted that the terms particularly and preferentially as used in claim 4 also lead to a confusion issue as to whether the preferred range is a claim limitation or not.

9. Regarding claim 8, the phrase "or similar" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 4,570,229 to Breen et al in view of U.S. Patent No. 5,913,371 to Jenne.

12. With respect to independent claim 1, Breen shows a method for the control of a rotary tablet forming machine where a rotor is capable of being rotated by means of a drive unit (Column 3, line 55), the rotor including at least one matrix ("die cavity") with allocated upper punches and lower punches and a pressing force (Column 5, lines 34-52), acting on the press mass filled into the one matrix at least, is determined (Column 1, lines 15-30 and lines 51 through Column 2, line 15), wherein the determined pressing force is compared with a pre-

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specifiable limit value (“pre-established limits” – Column 1, line 58) and, with a level going below the limit value, performing a corrective action (Column 1, line 51 through Column 2, line 15 – also see claim 1, part C).

13. With respect to independent claim 8, Breen shows a device for the control of a rotary tablet forming machine, with a control unit or similar for the control of a drive unit of a rotor of the rotary tablet forming machine (Figure 1, “Press controller 10”), a facility for determining a pressing force acting on a press mass as well as a means for comparing the determined pressing force with a pre-specifiable pressing force (Column 5, lines 34-52) and at least one means for performing a corrective action in dependence of the comparison of the determined pressing force with the pre-specifiable pressing force (Column 1, line 51 through Column 2, line 15 – also see claim 1, part C).

14. With relation to both claims 1 and 8, Breen does not show that this corrective action is to reduce the required speed of the rotor below the rated speed or “pre-specifying a required speed”.

15. Breen does show, however, corrective actions of adjusting the powder level, activating diverting gates, and “signals generated in response to the occurrence of one or more undesirable events for shutting down the tablet press”. Applicant should note that “shutting down the tablet press” does read on the claim element “reducing the speed below the rated speed”. Appropriate changes to the wording of this claim are required to avoid a USC 102 rejection (not given in this office action as it is clear that the spirit of the invention indicates that the speed is reduced, but not to zero).

16. The rated speed of a rotor is the maximum allowed operating speed at which it is safe to operate the rotor. The Jenne patent shows a rotary drive mechanism with a speed control based

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on the sensed condition that the maximum “feed force” has exceeded a user defined limit value.

“As soon as the limit values are exceeded, the feed speed and driving rotational movement are lowered”. It is assumed that most machines are run at their “rated speed” when in use as that provides maximum output.

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the speed control concepts set forth in the Jenne patent to control the speed of the rotor in the Breen patent because such a mechanism can prevent damage to the equipment caused by pressure in excess of a set limit (Column 1, lines 47-50 of Jenne).

18. Referring to claim 2, Breen shows wherein the pressing force is measured (“strain gauges” – Column 1, line 18).

19. Referring to claims 3 and 4, Breen shows wherein a difference between the limit value and a required pressing force can be set. Examiner assumes this claim to mean that the user can set the pressing force of the system to be a set percentage above the limit value for the measured pressing force. This is done automatically by Breen as the user can set and modify both the limit values and the required pressing force in order to create the best product as required by specifications.

20. Referring to claim 5, Breen shows wherein the required speed of the rotor is compared with an actual speed of the rotor; and the rotor is regulated to the required speed. Examiner notes that this is the point of any speed control system in any art and is done automatically once the user sets a speed until the desired speed is achieved. The term “required speed” is taken by examiner to mean “set point” for the speed controller.

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21. Referring to claims 6 and 7, Breen shows the speed control from both the standstill and the rated speed. Examiner again notes that a speed setting can be changed by the user at any time. This is related to claim 5 where the speed will automatically be adjusted until it reaches the desired speed regardless of the starting point.

### *Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

23. U.S. Patent No. 5,699,273 to Hinzpeter shows the control of a tablet-making machine based on the displacement of the pairs of punches.

24. U.S. Patent No. 5,838,571 to Lewis shows a table pressing machine with a control system based on the waveform of the pressure documented for each press.

25. All other prior art of record is related to tablet pressing machines and the operation thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Masinick whose telephone number is (571) 272-3746. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'MDM', is positioned above the printed name.

Michael D Masinick  
Examiner  
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MDM, October 27, 2005